

REMARKS

This amendment is in response to the Non-Final Office Action mailed on December 13, 2007 in which claims 22-33 were rejected. The Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

1. Rejection of Claims 22, 24, 26-29, and 33 Under 35 U.S.C. § 102(e) as Anticipated by Cole et al.

On page 2 of the Office Action, the Examiner rejected claims 22, 24, 26-29, and 33 under 35 U.S.C. § 102(e) as anticipated by Cole et al., U.S. Patent No. 6,387,098. The Applicant has amended independent claims 22 and 33 to overcome the rejection based on Cole et al.

Independent claim 22 and independent claim 33, as amended, both recite a “method of administering a substance to a bone” comprising, in combination with other steps, “introducing an insert into the cannulated portion of the bone screw shaft” and “placing the insert into a first position wherein the substance is maintained within the cannulated portion of the insert.” The amendments to claims 22 and 33 are supported by the specification as originally filed. See e.g., Application, paragraph [0047], paragraph [0053], and Fig. 4.

Cole et al. does not identically disclose a method including the step of “introducing an insert into the cannulated portion of the bone screw shaft” as recited in independent claims 22 and 33, as amended. In contrast, Cole et al. discloses an “intramedullary nail 10” having “channel grooves 1” and “catheter lines 14.” See col. 3, lines 30-40. The “channel grooves 1” extend along the outer surface of “intramedullary nail 10,” and “catheter lines 14” (identified as “an insert” by the Examiner) are positioned within “channel grooves 1.” See col. 4, lines 1-8 and Fig. 2. As such, Cole et

al. does not disclose the step of “introducing an insert into the cannulated portion of the bone screw shaft” as recited in independent claims 22 and 33, as amended.

Further, Cole et al. does not identically disclose a method including the step of “placing the insert into a first position wherein the substance is maintained within the cannulated portion of the insert” as recited in independent claims 22 and 33, as amended. In contrast, “the catheter lines 14” of Cole et al. are “positioned within a groove 1 [to] provide open communication with the adjacent bone.” See col. 4, lines 4-6 (emphasis added). In addition, “catheter lines 14” are made from “hollow, flexible tubing,” and there appears to be a gap or space between the outer surface of “catheter lines 14” and the inner surface of “channel grooves 1.” See col. 4, lines 9-12 and Fig. 2. As such, “the catheter lines 14” of Cole et al. appear to be configured such that, once a substance is introduced into “the catheter lines 14,” the substance is permitted to flow directly to the adjacent bone. Therefore, Cole et al. does not appear to disclose the step of “placing the insert into a first position wherein the substance is maintained within the cannulated portion of the insert” as recited in independent claims 22 and 33, as amended.

In view of the amendments to independent claims 22 and 33 and the arguments set forth above, the Applicant respectfully asserts that independent claim 22, corresponding dependent claims 24 and 26-29, and independent claim 33 are not anticipated by Cole et al. under 35 U.S.C. § 102(e).

2. Rejection of Claims 23 and 25 Under 35 U.S.C. § 103(a) Based Upon Cole et al. in View of Grayson

On page 3 of the Office Action, the Examiner rejected claims 23 and 25 under 35 U.S.C. § 103(a) as unpatentable over Cole et al. in view of Grayson, U.S. Patent No. 6,210,376. As discussed above, independent claim 22 has been amended to overcome the rejection based on Cole et al. Grayson does not overcome the deficiencies of Cole et al. The “trocar 11” of Grayson appears to have a solid shaft, which is not cannulated. See

col. 5, lines 2-4 and FIG 2. As such, Grayson does not appear to disclose an “insert ... wherein the substance is maintained within the cannulated portion of the insert” as recited in independent claim 22, as amended. Accordingly, dependent claims 23 and 25, which depend from independent claim 22, are presented for reconsideration and allowance.

3. Rejection of Claims 30 and 31 Under 35 U.S.C. § 103(a) Based Upon Cole et al. in View of Wigness et al.

On page 4 of the Office Action, the Examiner rejected claims 30 and 31 under 35 U.S.C. § 103(a) as unpatentable over Cole et al. in view of Wigness et al., U.S. Patent No. 5,203,770. As discussed above, independent claim 22 has been amended to overcome the rejection based on Cole et al. The “method and apparatus for catheterization” of Wigness et al. does not remedy the deficiencies of Cole et al. Wigness et al. discloses a “cannula arrangement 41” having an “internal channel [that] communicates through tap arrangement 40.” See col. 7, lines 56-58, and Fig. 5. As such, Wigness et al. does not appear to disclose an “insert ... wherein the substance is maintained within the cannulated portion of the insert” as recited in independent claim 22, as amended. Accordingly, claims 30 and 31, which depend from independent claim 22, are presented for reconsideration and allowance.

4. Rejection of Claim 32 Under 35 U.S.C. § 103(a) Based Upon Cole et al. in View of Gustilo

On page 4 of the Office Action, the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as unpatentable over Cole et al. in view of Gustilo, U.S. Patent No. 6,019,761. As discussed above, independent claim 22 has been amended to overcome the rejection based on Cole et al. The “intramedullary nail and method of use” of Gustilo does not remedy the deficiencies of Cole et al. Gustilo discloses a “sealing plug subassembly 92” that may be “positioned within the hollow space of IM nail 22.” See col. 10, lines 49-53, and Figs. 12 and 13. As such, Gustilo does not appear to disclose an “insert ... wherein

the substance is maintained within the cannulated portion of the insert” as recited in independent claim 22. Accordingly, claim 32, which depends from independent claim 22, is presented for reconsideration and allowance.

5. Claim 32

Applicant has amended claim 32 to more clearly recite the claimed subject matter. The amendment to claim 32 is not intended to change the scope of the claim. Applicant respectfully requests entry of the amendment to claim 32.

6. Conclusion

Claims 22-33 are pending in the present application. Claims 22, 32, and 33 have been amended. The Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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